

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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EFW

Applicant: Jenner Pearson et al.

Title: DYNAMIC SELECTION OF IMAGES FOR WEB PAGES

Docket No.: 2043.025US1

Serial No.: 09/589,585

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Due Date: October 6, 2007 (Sat.)

Examiner: Maikhanh Nguyen

Group Art Unit: 2176

MS Appeal Brief - Patents

Commissioner for Patents

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jennifer Pearson et al.

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AMENDED APPEAL BRIEF UNDER 37 CFR § 41.37

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The Amended Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 7, 2007, from the Final Rejection of claims 1-15 and 19-26 of the above-identified application, as set forth in the Final Office Action mailed on November 16, 2006, and in consideration of the Notification of Non-Compliant Appeal Brief mailed September 6, 2007.

Pursuant to MPEP § 1204.01, the Appeal fees previously paid by the Appellants with the Appeal Brief filed May 22, 2007 should have been applied to this Appeal Brief. However, if the Commissioner determines that additional fees are required, please charge the Appeal Brief fee set forth in 37 C.F.R. § 41.2(b)(2), as well as any additional required fees, to Deposit Account No. 19-0743.



AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, eBay Inc. as evidenced by the assignment from the inventors recorded June 7, 2000 at Reel 010858, Frame 0759.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on June 7, 2000 with claims 1-24. In response to a non-final Office Action mailed January 12, 2005, Appellants canceled claims 16-18 and added new claims 25-26. Two subsequent non-final Office Actions were mailed August 23, 2005 and May 18, 2006. A Final Office Action (hereinafter "the Office Action") was mailed November 16, 2006. Claims 1-15 and 19-26 stand twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

In response to the Final Office Action mailed November 16, 2006, Appellants proposed amendments to claims 13 and 26. However, in the Advisory Action mailed to Appellants on April 4, 2007 (hereinafter “the Advisory Action”), the Examiner indicated that the proposed amendments would not be entered for the purposes of Appeal. Specifically, the Advisory Action indicated that the proposed amendments to claims 13 and 26 significantly changed the scope of its own invention when interpreted as a whole. The proposed amendments to claims 13 and 16 are not regarded by the Appellants as being required to render these claims allowable. No other amendments have been made subsequent to the Final Office Action mailed November 16, 2006.

5. SUMMARY OF CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a “concise explanation of the subject matter defined in each of the independent claims involved in the appeal ...”. Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

CLAIM 1

Some aspects of the present inventive subject matter include, but are not limited to, a computerized method for selecting images for a markup language document (e.g., Fig. 2A; Fig. 2B, callout 213; page 7, lines 11-19). The method may include encoding an instruction in the markup language document (e.g., page 7, lines 14-16; page 8, lines 3-4), identifying a utility program (e.g., Fig. 2A, callout 203; page 7, lines 15-16; page 8, line 4) that selects an image for insertion into the document (e.g., Fig. 2A, callout 205; Fig. 2B, callout 213; page 7, line 18; page 8, lines 17-18; page 9, line 1). The method may also include preparing the markup language document for display (e.g., Fig. 5, callout 510; Page 8, line 21); invoking the utility program when the instruction is processed (e.g., Fig. 2B, callout 213; Page 3, line 13; page 7, lines 15-17) and selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction (e.g., Fig. 2A, callout 205; Fig. 2B, callout 213; page 3, lines 14-15; page 7, line 18; page 8, lines 17-18). The utility program (e.g., Fig. 2A, callout 203; Fig. 2B, callout 203) may place the pre-determined number of images in the markup language document (e.g., Fig. 2A, callout 205; Fig. 2B, callout 205; Fig. 3A, callout 309) at locations defined in the instruction (e.g., page 7, line 19; page 11, lines 9-10).

CLAIM 2

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 1 wherein the group of images may include a gallery containing images available for display (e.g. Fig. 2A, callout 201; page 3, lines 15-16; page 8, lines 3-5; page 9 lines 5-8).

CLAIM 3

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 1 wherein the group of images may include a pool of images (e.g., page 12, lines 8-9; page 16, lines 21; Fig. 2A, callout 205. The method may further choose the images for the pool from a gallery containing images available for display using an administration tool. (e.g. Fig. 1A, callout 211; page 9, lines 5-8; page 12, lines 1-5).

CLAIM 4

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 3 wherein the choosing of the images for the pool may include obtaining filtering criteria (e.g. Fig. 4, callout 425; page 8, lines 21-21; page 9, lines 5-8 and lines 18-20); identifying an image from the gallery based on the filtering criteria (page 8, line 20; page 9, lines 13-14); and adding the identified image to the pool (Fig. 4, callout 423; page 8, lines 20-21; page 12, lines 6-7).

CLAIM 5

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 4 further including examining information associated with the image against a set of standards (e.g. Fig. 4, callout 415; page 12, lines 14-16). The method may further discard the image if the information does not meet the standards (e.g. Fig. 4, callout 415; page 12, lines 14-19).

CLAIM 6

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 4 further including deleting an image from the pool (e.g. Fig. 4, callout 415; page 12, lines 14-19).

CLAIM 7

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 1 wherein the markup language document may be a web page

(e.g., page 3, lines 11-12; Fig. 2A callout 205) and the instruction may be a tag in the proprietary format (e.g., page 3, lines 12-13).

CLAIM 8

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 7 wherein the utility program may be invoked when the tag in the proprietary format is processed during a compile of the web page (e.g. page 8, lines 8-9, and 13-14).

CLAIM 9

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 7, wherein the proprietary format may include widget identifier, number of images, and display parameters (e.g. page 8, lines 3-6).

CLAIM 10

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 9, wherein the display parameters may comprise a size parameter and a location parameter (e.g. page 8, lines 3-12).

CLAIM 11

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 7, wherein the proprietary format may include widget identifier, category identifier, number of images, display parameters (e.g. page 8, lines 3-6).

CLAIM 12

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 1 further including validating the pre-determined number of images against validation criteria (e.g. Fig. 3B, callout 310; page 11, lines 11-14); and substituting a different image for an image that fails the validation (e.g., page 11, lines 14-17).

CLAIM 13

Some aspects of the present inventive subject matter include, but are not limited to, a computer-readable medium (e.g., Fig. 5, callout 524; page 14, lines 12-13) having stored thereon executable instructions for causing a computer to perform a utility program (e.g., Fig. 2A, callout 203, Fig. 2B, callout 203) for selecting images for a markup language document (e.g., Fig. 2A, callout 205; Fig. 2B, callouts 205 and 213; page 7, line 18; page 8, lines 17-18; page 9, line 1). The utility program may determine a number of images to display in the markup language document (e.g., Fig. 2B, callout 213; Fig. 3A, callout 301; page 11, line 3); obtain a set of random numbers corresponding to the number of images (e.g., Fig. 3A, callout 303; page 11, lines 4-5); and retrieve images from a group of images using the set of random numbers (e.g., Fig. 3A, callout 305; page 11, lines 6-7). The utility program may also place the retrieved images in the markup language document (e.g., Fig. 2A, callout 203; Fig. 2B, callout 203; Fig. 3A, callout 309).

CLAIM 14

Some aspects of the present inventive subject matter include, but are not limited to the computer-readable medium of claim 13 further including executable instructions that upon execution may validate the retrieved images against validation criteria (e.g. Fig. 3B, callout 310; page 11, lines 11-14) and if a retrieved image fails the validation, retrieve a replacement image from the group of images (e.g., page 11, lines 14-17).

CLAIM 15

Some aspects of the present inventive subject matter include, but are not limited to the computer-readable medium of claim 13 further including 13 having further executable instructions that upon execution may determine a location in the document for each of the retrieved images from an instruction embedded in the document (e.g. page 11, lines 9-10).

CLAIM 19

Some aspects of the present inventive subject matter include, but are not limited to, a computer system (e.g., Fig. 5; page 14, lines 3-10). The computer system may include a processing unit (e.g., Fig. 5, callout 502; page 14, line 4); a memory (e.g., Fig. 5, callouts 504 and 506; page 14, lines 4-5) coupled to the processing unit through a system bus (e.g., Fig. 5, callout 508; page 14, line 5). The computer system may further include a computer-readable medium (e.g., Fig. 5, callout 524, page 14, lines 23-13) coupled to the processing unit through the system bus, and an instruction (e.g., Fig. 5, callout 526; page 14, lines 13-17) embedded in a markup language document in the memory to cause the processing unit to execute a utility program (e.g., Fig. 2A, callout 203; Fig. 2B, callout 203; Page 7, lines 15-16; page 8, line 4) from the computer-readable medium. The utility program may cause the processing unit to determine a number of images to display in the markup language document (e.g., Fig. 2B, callout 213; Fig. 3A, callout 301; page 11, line 3), select the number of images from a group of images (e.g., Fig. 2A, callout 205; Fig. 2B, callout 213; page 3, lines 14-15; page 7, line 18; page 8, lines 17-18), and place the selected images in the markup language document (e.g., Fig. 2A, callout 203; Fig. 2B, callout 203; Fig. 3A, callout 309).

CLAIM 20

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 19, wherein the utility program may cause the processing unit to place the selected images in a location defined in the instruction (e.g., Fig. 2A, callout 205; Fig. 2B, callout 205; Fig. 3A, callout 309).

CLAIM 21

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 19, wherein the instruction may specify the number of images to display (e.g., page 11, lines 2-5).

CLAIM 22

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 19, wherein the computer-readable medium may further include an administration program that may cause the processing unit to create a group of images from which to select the number of images (e.g., page 3, lines 16-18; page 16, lines 20-21).

CLAIM 23

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 19, wherein the computer system is a web server and the markup language document is a web page (e.g., page 3, lines 11-12, page 6, lines 11-13; Fig. 1, callout 12).

CLAIM 24

Some aspects of the present inventive subject matter include, but are not limited to the computerized method of claim 23, wherein the web page contains images of items being auctioned on a web site hosted by the web server (e.g., page 7, lines 20 to page 8 line 3, page 9, lines 5-9).

CLAIM 25

Some aspects of the present inventive subject matter include, but are not limited to, a system for selecting images for a markup language document (e.g., Fig. 2A; Fig. 2B, callout 213; Page 7, lines 11-19). The system may include means for encoding an instruction in the markup language document (e.g., page 7, lines 14-16; page 8, lines 3-4), the instruction identifying a utility program (e.g., Fig. 2A, callout 203; page 7, lines 15-16; page 8, line 4). The utility program may select an image for insertion into the document (e.g., Fig. 2A, callout 205; Fig. 2B, callout 213; page 7, line 18; page 8, lines 17-18; page 9, line 1). The system may also include means for preparing the markup language document for display (e.g., Fig. 5, callout 510; page 8, line 21); means for invoking the utility program when the instruction is processed (e.g., Fig. 2B, callout 213; page 3, line 13; page 7, lines 15-17); and means for selecting, by the utility program, a pre-determined number of images from a group of images (e.g., Fig. 2A, callout 205; Fig. 2B, callout 213; page 3, lines 14-15; page 7, line 18; page 8, lines 17-18). The pre-determined number may be specified in the instruction (e.g., page 7, line 19; page 11, lines 9-10). The system may further include means for placing, by the utility program (e.g., Fig. 2A, callout 203; Fig. 2B, callout 203), the pre-determined number of images in the markup language document (e.g., Fig. 2A, callout 205; Fig. 2B, callout 205; Fig. 3A, callout 309) at locations defined in the instruction (e.g., page 7, line 19; page 11, lines 9-10).

CLAIM 26

Some aspects of the present inventive subject matter include, but are not limited to, a system for selecting images for a markup language document (e.g., Fig. 2A; Fig. 2B, callout 213; page 7, lines 11-19). The system may include means for determining a number of images to display in the markup language document (e.g., Fig. 2B, callout 213; Fig. 3A, callout 301; page 11, line 3); means for obtaining a set of random numbers corresponding to the number of images (e.g., Fig. 3A, callout 303; page 11, lines 4-5). The system may also include means for retrieving images from a group of images using the set of random numbers (e.g., Fig. 3A, callout 305; page 11, lines 6-7); and means for placing the retrieved images in the markup language document (e.g., Fig. 2A, callout 203; Fig. 2B, callout 203; Fig. 3A, callout 309).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

§102 Rejection of the Claims

Claims 1-11, 13, 15 and 19-26 were rejected under 35 U.S.C. § 102(e) for anticipation by Langheinrich et al. (U.S. 6,654,725, hereinafter “Langheinrich”).

§103 Rejection of the Claims

Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Langheinrich et al. in view of McCollom et al. (U.S. 6,925,444, hereinafter “McCollom”).

7. ARGUMENT

§102 Rejection of the Claims

Claims 1-11, 13, 15 and 19-26 were rejected under 35 U.S.C. § 102(e) for anticipation by Langheinrich et al. (U.S. 6,654,725, hereinafter “Langheinrich”).

Appellants respectfully traverse this rejection because the Office Action has not made out a *prima facie* case of anticipation.

A) The Applicable Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. PPG Industries, Inc. V. Guardian Industries Corp., 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

B) Discussion of the rejection of claims

Discussion of claims 13 and 26

Claim 13 recites, “determining a number of images to display in the markup language document; obtaining a set of random numbers corresponding to the number of images; retrieving images from a group of images using the set of random numbers; and placing the retrieved images in the markup language document.”

Langheinrich described a system and method for customized advertisement selection and delivery on the World Wide Web (WWW) upon the Internet. The advertising system has a database server which stores advertisements and their campaign information, and an advertisement server which generates electronic advertisements available to a client system. (Langheinrich , Abstract) The Final Office Action mailed November 16, 2006 (hereinafter “the Office Action”) at page 3, alleges that Langheinrich, at col. 4, lines 20-41, teaches the claim

feature of, “determining a number of images to display in the markup language document.” In the cited passage, Langheinrich states:

The advertisement server 103 handles incoming requests from clients to deliver customized advertisements. It contacts the database server 104 in order to obtain the data relevant to make an advertisement selection. . . . Advertisers can contact a maintenance server 106 that allows direct access to the advertisement information stored in the database server 104.
(Col.4, lines 20-41)

The advertisement server in the quoted text handles incoming requests from clients to deliver advertisements.. The above-quoted passage clearly is silent on the claimed feature of *determining a number of images* to display. On page 2 of the Advisory Action, the Examiner asserts that the relevant feature is taught in the following passage of Langheinrich:

. . . The list of display probabilities is encoded and outputted by an encoding module 2003. . . . After compiling this display distribution for all advertisements in a relevancy computation module 2002, the system chooses a random advertisement according to the given probabilities (weight) 2005. . . . The script will first contact the database server to obtain a list of current advertisements to show in step 1302. This list contains not only the ID of the advertisement, but also the requested daily impression rate and a list of manually configured customization parameters. The requested daily rate is computed as follows. Each advertisement is scheduled to be shown a certain number of times (called "impressions") over a certain period of time. This is called an advertisement "run". The daily rate is simply the number of impressions scheduled minus the number of impressions already shown, divided by the remaining time in the period this advertisement should be shown. The time can be expressed in days, hours or even seconds, as long as it is used consistently across all runs . . .
(Langheinrich, col. 7, line 61- col. 8, line 48) (Emphasis added)

The above text states that the script obtains a list of current advertisements to show. However, obtaining a list of advertisement is not the same as *determining a number of images to display*. The list mentioned in the above text contains identifiers (IDs) of advertisements, the requested daily impression rates, and a list of manually configured customization parameters. Because none of the information contained in the list is said to include *a number of images* (construed as advertisements by the Examiner), obtaining the list does not amount to *determining a number of images*. Clearly, an advertisement cannot properly be equated to an image, as an advertisement may or may not include an image. Further, consider that an advertisement may contain multiple images. Langheinrich’s description of obtaining “a list of current

advertisements to show” clearly does not amount to a teaching of “determining a number of images to display”, as required by claim 13.

Further, obtaining a list of advertisements in no way amounts to any determination operation, and specifically not a determination operation regarding a number of images to display. For example, the obtained list may be a static list, and the obtaining operation may well include no numerical determination component. To assume otherwise, is pure speculation.

As such, the quoted passages quite clearly fails to disclose, “*determining a number of images to display in the markup language document*,” as recited in claim 13.

With respect to the claim 13 limitation, “obtaining a set of random numbers corresponding to the number of images,” the Office Action, at page 3, asserts that Langheinrich at col. 1, lines 39-40, col. 1, lines 16-32, and col. 8, lines 1-18 teaches that feature. In the cited passages, Langheinrich states:

The remaining advertisements will then be selected randomly.
(Langheinrich, col. 1, lines 39-40).

Nowadays, the Internet is very popular with the consuming public and WWW (World Wide Web) pages on the Internet are considered powerful media for advertising. In its simplest form, web advertisement is directly linked as fixed inline images into a web page. More flexible systems allow a separation of advertisement selection and placement, but offer only a random selection mechanism. . . . Moreover, each user who requests the page for display will potentially see a different inline image since the selection process is called for each user individually.
(Langheinrich, col. 1, lines 16-32).

The list of display probabilities is encoded and outputted by an encoding module 2003. For each value of a customization variable, this list of probabilities for each advertisement has to add up to 1.0, i.e. in every case the system has to be able to choose one and only one of the available advertisements. After compiling this display distribution for all advertisements in a relevancy computation module 2002, the system chooses a random advertisement according to the given probabilities (weight) 2005. . . .
(Langheinrich, col. 8, lines 1-18) (Emphasis added).

The above passages describe that advertisements are selected randomly. In contrast with *obtaining a set of random numbers corresponding to the number of images*, it is merely stated that a list of display distributions for all advertisements is compiled in a relevancy computation module. However, a list of display distributions does not equate a *set of random numbers*

corresponding to the number of images. Consider that, for 10 advertisements, a list of probabilities for each advertisement consisting of 10 numbers each being, for example, equal to 0.1 would add up to 1; nonetheless, this example list does not constitute a set of random numbers, much less a set of random numbers corresponding to the number of images. Thus, the above passages fail to specifically disclose “*obtaining a set of random numbers corresponding to the number of images,*” as recited in claim 13.

With regards to claim 13 limitation, “retrieving images from a group of images using the set of random numbers,” the Office Action asserts that the feature is taught at col. 1 lines 16-46 and col. 8 lines 1-18 of Langheinrich. As discussed above, the relevant passages of Langheinrich do not disclose a *set of random numbers corresponding to the number of images*. As such, the cited passages do not teach the feature of, “*retrieving images from a group of images using the set of random numbers,*” as recited in claim 13.

Therefore, Appellants respectfully submit that, for at least the reasons set forth above, Langheinrich fails to teach each and every element of claim 13. Thus, the reversal of the claim rejection under 35 U.S.C. § 102(e) is requested.

The same arguments as presented with respect to claim 13 are also applicable to a consideration of claim 26. As such, Appellants respectfully submit that, at least for the same reasons noted above, Langheinrich does not anticipate claim 26 and it is requested the claim rejection be reversed.

Claim 15 is dependent on independent claim 13. Since a dependent claim is deemed to include all limitations of a claim from which it depends, for at least the same reasons noted above, Appellants respectfully submit that Langheinrich does not anticipate claim 15. Thus, the reversal of the claim rejection is requested.

Discussion of claim 19

Claim 19 recites, “the utility program causes the processing unit to determine a number of images to display in the markup language document.” Appellants respectfully submit that, at least for the reasons noted above, Langheinrich does not describe the claimed feature of, “*determine a number of images to display in the markup language document,*” as recited in claim 19. In addition, The Office Action at page 6 cites, “incoming requests from the clients to

deliver customized advertisement,” from the reference as teaching the claimed feature of, “the utility program causes the processing unit to determine a number of images.” Clearly, customized advertisement cannot properly be equated to a number of images, as an advertisement may or may not include an image. Further, consider that customized advertisement may contain multiple images. Langheinrich’s description of “incoming requests from the clients to deliver customized advertisement” clearly does not amount to a teaching of “the utility program causes the processing unit to determine a number of images”, as required by claim 19. Additionally, because a request to deliver something does not obligate the deliverer to determine a number of that thing, clearly, incoming requests from the clients to deliver customized advertisement, even when handled by a server, does not amount to *causing the processing unit to determine a number of images*. As such, at least for the reasons set forth above, Langheinrich does not teach each and every element of claim 19. Therefore, Appellants respectfully request the reversal of the claim rejection under 35 U.S.C. § 102(e).

Claims 20-24 are dependent on independent claim 19. Thus, they are deemed to include all limitations of a claim 19 discussed above. As such, Appellants respectfully submit that, for at least the same reasons noted above, Langheinrich does not anticipate claims 20-24. Therefore, the reversal of the claim rejection under 35 U.S.C. § 102(e) is requested.

Discussion of claims 1 and 25

Claim 1 recites, “selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction.” The Examiner, on page 3 of the Advisory Action, alleges that Langheinrich teaches, at col. 4, lines 21-41 and col. 6, lines 38-63, the above claim limitation. The cited passages describe:

The advertisement server 103 handles incoming requests from clients to deliver customized advertisements. It contacts the database server 104 in order to obtain the data relevant to make an advertisement selection. . . . Once a selection is made, this selection will be logged with the database server. . . . Advertisers can contact a maintenance server 106 that allows direct access to the advertisement information stored in the database server 104.
(Col. 4, lines 21-41) (Emphasis added)

Alternatively, the system can perform advertisement selection and delivery in a single process, as shown in the data flow diagram in FIG. 9B. After contacting [1] the content server 101, the corresponding script simple includes the customization parameters into the HTML image tag and returns [2] the results page to the user's web browser 102. The browser 102 again contacts [3] the advertisement server 103 for the actual image data, only this time including the customization parameters instead of the advertisement ID when starting the selection process [4]. As described in step 1005 in FIG. 3, the selection process 119 will find the embedded customization parameters to request and perform the selection after obtaining the relevant information [5], [6] from the database server 104. . . . (Col. 6. lines 38-63) (Emphasis added)

In the above texts the advertisement server handles incoming request from clients . . . to obtain data relevant to make an advertisement selection. Clearly, an advertisement cannot properly be equated to a predetermined number of images, as an advertisement may or may not include an image. Furthermore, consider that an advertisement may contain multiple images. Langheinrich's description of contacting the database server "to obtain data relevant to make an advertisement selection" clearly does not amount to a teaching of "selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction," as required by claim 1. The passage also states that the system can perform advertisement selection and delivery in a single process. Performing advertisement selection does not amount to a teaching of "*selecting, by the utility program, a pre-determined number of images, from a group of images . . .*", as recited in claim 1. As such, the reference does not disclose, "*selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction,*" as recited in claim 1. Therefore, Appellants respectfully submit that, at least for the reasons set forth above, claim 1 is not anticipated by Langheinrich. As such, the reversal of the claim rejection under 35 U.S.C. § 102(e) is requested.

As for claim 25, the arguments presented above with respect to claim 1 are also applicable to a consideration of claim 25. Therefore, Appellants respectfully submit that, for at least the same reasons noted above, claim 25 is allowable. Thus, it is respectfully requested the claim rejection under 35 U.S.C. § 102(e) be reversed.

Claims 2-11 are dependent on independent claim 1. Since a dependent claim is deemed to include all limitations of a claim from which it depends, for at least the same reasons noted above, Appellants respectfully submit that Langheinrich does not anticipate claims 2-11. As such, the reversal of the claim rejection under 35 U.S.C. § 102(e) is requested.

§103 Rejection of the Claims

Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Langheinrich et. al. in view of McCollom et al. (U.S. 6,925,444, hereinafter “McCollom”).

A) The Applicable Law

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

B) Discussion of the rejection of claims

Discussion of claims 12 and 14

Appellants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness for the reason that, even if combined, the cited references fail to teach or suggest all of the elements of Applicants’ claimed invention.

The reference (or references when combined) must teach or suggest all the claim elements. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 12 and 14 are dependent on claims 1 and 13, respectively. Thus, they are deemed to include the same limitations as discussed above. As such, at least for the same reasons set forth above, the combination of Langheinrich and McCollom does not teach or suggest all the claim elements, and therefore fails to render the claims obvious. Thus, Appellants respectfully request that the claim rejections under 35 U.S.C. § 103 be reversed.

8. SUMMARY

For the reasons argued above, claims 1-11, 13, 15 and 19-26 were not properly rejected under 35 U.S.C. § 102(e) for anticipation by Langheinrich et al. Nor were claims 12 and 14 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Langheinrich et al. in view of McCollom et al.

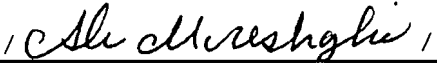
It is respectfully submitted that the arts cited do not render the claims anticipated or obvious and that the claims are patentable over the cited arts. Reversal of the rejections and allowance of the pending claims are respectfully requested.

Respectfully submitted,


JENNIFER PEARSON et al.

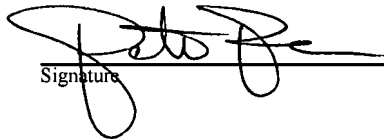
By their Representatives,

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Date October 05, 2007 By 
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5 day of October 2007.

Name 


Signature

CLAIMS APPENDIX: THE CLAIMS ON APPEAL

1. (Rejected) A computerized method for selecting images for a markup language document comprising:
 - encoding an instruction in the markup language document, the instruction identifying a utility program that selects an image for insertion into the document;
 - preparing the markup language document for display;
 - invoking the utility program when the instruction is processed;
 - selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction; and
 - placing, by the utility program, the pre-determined number of images in the markup language document at locations defined in the instruction.
2. (Rejected) The computerized method of claim 1, wherein the group of images comprises a gallery containing images available for display.
3. (Rejected) The computerized method of claim 1, wherein the group of images comprises a pool of images and the method further comprising:
 - choosing the images for the pool from a gallery containing images available for display using an administration tool.
4. (Rejected) The computerized method of claim 3, wherein choosing the images for the pool comprises:
 - obtaining filtering criteria;
 - identifying an image from the gallery based on the filtering criteria; and
 - adding the identified image to the pool.
5. (Rejected) The computerized method of claim 4 further comprising:
 - examining information associated with the image against a set of standards; and
 - discarding the image if the information does not meet the standards.

6. (Rejected) The computerized method of claim 4 further comprising:
deleting an image from the pool.
7. (Rejected) The computerized method of claim 1, wherein the markup language document is a web page and the instruction is a tag in the proprietary format.
8. (Rejected) The computerized method of claim 7, wherein the utility program is invoked when the tag in the proprietary format is processed during a compile of the web page.
9. (Rejected) The computerized method of claim 7, wherein the proprietary format comprises:
widget identifier, number of images, display parameters.
10. (Rejected) The computerized method of claim 9, wherein the display parameters comprise a size parameter and a location parameter.
11. (Rejected) The computerized method of claim 7, wherein the proprietary format comprises:
widget identifier, category identifier, number of images, display parameters
12. (Rejected) The computerized method of claim 1 further comprising:
validating the pre-determined number of images against validation criteria; and
substituting a different image for an image that fails the validation.
13. (Rejected) A computer-readable medium having stored thereon executable instructions for causing a computer to perform a utility program for selecting images for a markup language document comprising:
determining a number of images to display in the markup language document;
obtaining a set of random numbers corresponding to the number of images;

retrieving images from a group of images using the set of random numbers; and
placing the retrieved images in the markup language document.

14. (Rejected) The computer-readable medium of claim 13 having further executable instructions comprising:

validating the retrieved images against validation criteria; and

retrieving a replacement image from the group of images if a retrieved image fails the validation.

15. (Rejected) The computer-readable medium of claim 13 having further executable instructions comprising:

determining a location in the document for each of the retrieved images from an instruction embedded in the document.

19. (Rejected) A computer system comprising:

a processing unit;

a memory coupled to the processing unit through a system bus;

a computer-readable medium coupled to the processing unit through the system bus, and

an instruction embedded in a markup language document in the memory to cause the processing unit to execute a utility program from the computer-readable medium, wherein the utility program causes the processing unit to determine a number of images to display in the markup language document, select the number of images from a group of images, and place the selected images in the markup language document.

20. (Rejected) The computer system of claim 19, wherein the utility program causes the processing unit to place the selected images in a location defined in the instruction.

21. (Rejected) The computer system of claim 19, wherein the instruction specifies the number of images to display.

22. (Rejected) The computer system of claim 19, wherein the computer-readable medium further comprises an administration program that causes the processing unit to create a group of images from which to select the number of images.

23. (Rejected) The computer system of claim 19, wherein the computer system is a web server and the markup language document is a web page.

24. (Rejected) The computer system of claim 23, wherein the web page contains images of items being auctioned on a web site hosted by the web server.

25. (Rejected) A system for selecting images for a markup language document, the system comprising:

- means for encoding an instruction in the markup language document, the instruction identifying a utility program that selects an image for insertion into the document;

- means for preparing the markup language document for display;

- means for invoking the utility program when the instruction is processed;

- means for selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction; and

- means for placing, by the utility program, the pre-determined number of images in the markup language document at locations defined in the instruction.

26. (Rejected) A system for selecting images for a markup language document, the system comprising:

- means for determining a number of images to display in the markup language document;

- means for obtaining a set of random numbers corresponding number of images;

- means for retrieving images from a group of images using the set of random numbers;

and

- means for placing the retrieved images in the markup language document.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.